

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re PATENT APPLICATION of:

MORTEN

Appln. No.: 09/787,371

Filed: March 16, 2001

FOR: POLYMORPHISMS IN THE HUMAN VCAM-1 GENE, SUITABLE FOR
DIAGNOSIS AND TREATMENT OF VCAM-1 LIGAND MEDIATED DISEASES

Date: April 25, 2001

**REQUEST FOR CLARIFICATION OF
NOTIFICATION OF MISSING REQUIREMENTS**Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

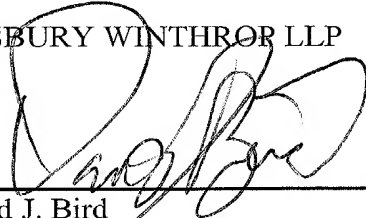
Sir:

This is in response to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office dated April 17, 2001 (copy attached), which Notification does not acknowledge receipt of the "Oath or Declaration of Inventors." All necessary parts of this application, including an executed declaration, were submitted with the application as filed on March 16, 2001. This is clearly shown by the copy of the application as filed, which notes on page 2, paragraph 15, that the declaration "is submitted herewith". The timely filing of this paper is evidenced by the attached copies of the PTO-Mail Room stamped postcard receipts, acknowledging receipt of the "Declaration (1 # pgs). Although the Notice does not expressly request that an oath or declaration be filed for completion, clarification including an acknowledgement that the declaration was received is respectfully requested.

With regard to the requirement for Sequence Listing in the Notification of Missing Requirements, the sequence listing is being prepared and will be filed in due course along with a further copy of the Notice.

Respectfully Submitted,

PILLSBURY WINTHROR LLP



By:

1100 New York Avenue, N.W.
Ninth Floor, East Tower
Washington, D.C. 20005-3918
DJB:mk

Donald J. Bird
Registration No. 25,323
Tel. No.: (202) 861-3027
Fax No.: (202) 822-0944

PAT-112CN 10/00

RE: USA National Filing of PCT GB99/03057

11. ☒ **PLEASE AMEND** the specification before its first line by inserting as a separate paragraph:
 a. ☒ --This application is the national phase of international application PCT/GB99/03057
 filed September 15, 1999 which designated the U.S.--
 b. ☐ --This application also claims the benefit of U.S. Provisional Application No.
 60/_____, filed _____.--
12. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)), i.e., **before 18th month** from first priority date above in item 3, are transmitted herewith (file only if in English) including:
13. ☒ PCT Article 19 claim amendments (if any) have been transmitted by the International Bureau
14. ☐ Translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)), i.e., of **claim amendments** made before 18th month, is attached (**required by 20th month from the date in item 3 if box 4(a) above is X'd, or 30th month if box 4(b) is X'd, or else amendments will be considered canceled**).
15. **A declaration of the inventor** (35 U.S.C. 371(c)(4))
 a. ☒ is submitted herewith ☒ Original ☐ Facsimile/Copy
 b. ☐ is not herewith, but will be filed when required by the forthcoming PTO Missing Requirements Notice per Rule 494(c) if box 4(a) is X'd or Rule 495(c) if box 4(b) is X'd.
16. **An International Search Report (ISR):**
 a. Was prepared by ☒ European Patent Office ☐ Japanese Patent Office ☐ Other
 b. ☒ has been transmitted by the international Bureau to PTO.
 c. ☒ copy herewith (2 pg(s).) ☒ plus Annex of family members (2 pg(s).).
17. **International Preliminary Examination Report (IPER):**
 a. ☒ has been transmitted (if this letter is filed after 28 months from date in item 3) in English by the International Bureau with Annexes (if any) in original language.
 b. ☒ copy herewith in English.
 c.1 ☐ IPER Annex(es) in original language ("Annexes" are amendments made to claims/spec/drawings during Examination) including attached amended:
 c.2 ☐ Specification/claim pages #____ claims #____
 Dwg Sheets #____
 d. ☐ Translation of Annex(es) to IPER (**required by 30th month due date, or else annexed amendments will be considered canceled**).
18. **Information Disclosure Statement** including:
 a. ☒ Attached Form PTO-1449 listing documents
 b. ☐ Attached copies of documents listed on Form PTO-1449
 c. ☒ A concise explanation of relevance of ISR references is given in the ISR.
19. ☒ **Assignment** document and Cover Sheet for recording are attached. Please mail the recorded assignment document back to the person whose signature, name and address appear at the end of this letter.
20. ☐ Copy of Power to IA agent.
21. ☐ **Drawings** (complete only if 8d or 10a(4) not completed): ____ sheet(s) per set: ☐ 1 set informal;
☐ Formal of size ☐ A4 ☐ 11"
22. Small Entity Status ☐ is **Not** claimed ☐ is claimed (**pre-filing confirmation required**)
 22(a) ____ (No.) Small Entity Statement(s) enclosed (since 9/8/00 Small Entity Statements(s) not essential to make claim)
23. **Priority** is hereby claimed under 35 U.S.C. 119/365 based on the priority claim and the certified copy, both filed in the International Application during the international stage based on the filing in (country) GREAT BRITAIN of:
- | | <u>Application No.</u> | <u>Filing Date</u> | | <u>Application No.</u> | <u>Filing Date</u> |
|-----|------------------------|-----------------------|-----|------------------------|--------------------|
| (1) | <u>9820338.3</u> | <u>Sept. 19, 1998</u> | (2) | _____ | _____ |
| (3) | _____ | _____ | (4) | _____ | _____ |
| (5) | _____ | _____ | (6) | _____ | _____ |
- a. ☒ See Form PCT/IB/304 sent to US/DO with copy of priority documents. If copy has not been received, **please proceed promptly to obtain same from the IB.**
 b. ☐ Copy of Form PCT/IB/304 attached.

RE: USA National Filing of PCT/GB99/03057

24. Attached: 1 page of Sequence Listing and 2 copies of Form PCT/IB/306

25. **Preliminary Amendment:**25.5 Per Item 17.c.2, cancel original pages #_____, claims #_____, Drawing Sheets #26. **Calculation of the U.S. National Fee (35 U.S.C. 371 (c)(1)) and other fees is as follows:**Based on amended claim(s) per above item(s) ☐ 12, ☐ 14, ☐ 17, ☐ 25, ☐ 25.5 (hilitte)

Total Effective Claims	12	minus 20 =	0	x \$18/\$9	=	\$0	966/967
Independent Claims	8	minus 3 =	5	x \$80/\$40	=	\$400	964/965
If any proper (ignore improper) Multiple Dependent claim is present,				add \$270/\$135	+	270	968/969

BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(4)): →→ **BASIC FEE REQUIRED, NOW** →→→→A. If country code letters in item 1 are not "US", "BR", "BB", "TT", "MX", "IL", "NZ", "IN" or "ZA"

See item 16 re:

1. Search Report was <u>not</u> prepared by EPO or JPO -----	add \$1000/\$500		960/961
2. Search Report was prepared by EPO or JPO -----	add \$860/\$430	+860	970/971

SKIP B, C, D AND E UNLESS country code letters in item 1 are "US", "BR", "BB", "TT", "MX", "IL", "NZ", "IN" or "ZA"

→ <input type="checkbox"/> B. If <u>USPTO</u> did not issue <u>both</u> International Search Report (ISR) <u>and</u> (if box 4(b) above is X'd) the International Examination Report (IPER), -----	add \$970/\$485	+0	960/961
(only) (one) → <input type="checkbox"/> C. If <u>USPTO</u> issued ISR but not IPER (or box 4(a) above is X'd), -----	add \$710/\$355	+0	958/959
(of) (these) (4) → <input type="checkbox"/> D. If <u>USPTO</u> issued IPER but IPER Sec. V boxes <u>not all</u> 3 YES, -----	add \$690/\$345	+0	956/957
(boxes) → <input type="checkbox"/> E. If international preliminary examination fee was paid to <u>USPTO</u> <u>and</u> Rules 492(a)(4) and 496(b) <u>satisfied</u> (IPER Sec. V <u>all</u> 3 boxes YES for <u>all</u> claims), -----	add \$100/\$50	+0	962/963

27. **SUBTOTAL =** \$153028. If Assignment box 19 above is X'd, add Assignment Recording fee of ----\$40 +40 (581)29. Attached is a check to cover the ----- **TOTAL FEES** \$1570

Our Deposit Account No. 03-3975

Our Order No. 9901 | 277176
C# M#

00909

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 and 492 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown above for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filedPillsbury Winthrop LLP
Intellectual Property GroupBy Atty: Donald J. BirdReg. No. 25323

Sig: _____

Fax: (202) 822-0944
Tel: (202) 861-3027

Atty/Sec: DJB/mhn

NOTE: File in duplicate with 2 postcard receipts (PAT-103) & attachments.

Pat-103 11/97 PTO RECEIPT FOR INDICATED ITEMS

Appln. No.: 0 /
 Inventor(s): MORTEN, John E.N.
 Title: POLYMORPHISMS....
 ENCLOSED:

Atty: DJB
 Date: March 16, 2001
 C#: 9901
 M#: 277176



COPY

Amendment
 # 1 No. of Pages Abstract
 # 18 No. of Pages Spec and Claims
 # 11 No. of numbered Claims only
 Declaration (1 # pgs)
 Assignment [x] Cover Sheet
 No. of Priority Documents
 No. Sheets Drawings (fig(s) 1 to) [] 1 set Formal
 [] IDS Letter [] cited App. [X] Foreign sch rept./OA
 [x] PTO-1449 [] cited docs.
 \$ 1570 Fee (Check)

Other: REQUEST, IPER, 1 page of Sequence Listing and 2 copies
 of Form PCT/IB/306

CURRENT DUE DATE: March 19, 2001

Pat-103 11/97 PTO RECEIPT FOR INDICATED ITEMS

Appln. No.: 0 /
 Inventor(s): MORTEN, John E.N.
 Title: POLYMORPHISMS....
 ENCLOSED:

Atty: DJB
 Date: March 16, 2001
 C#: 9901
 M#: 277176

Amendment
 # 1 No. of Pages Abstract
 # 18 No. of Pages Spec and Claims
 # 11 No. of numbered Claims only
 Declaration (1 # pgs)
 Assignment [x] Cover Sheet
 No. of Priority Documents
 No. Sheets Drawings (fig(s) 1 to) [] 1 set Formal
 [] IDS Letter [] cited App. [X] Foreign sch rept./OA
 [x] PTO-1449 [] cited docs.
 \$ 1570 Fee (Check)

Other: REQUEST, IPER, 1 page of Sequence Listing and 2 copies
 of Form PCT/IB/306

JCO9 Rec'd PCT/PTO 16 MAR 2001

CURRENT DUE DATE: March 19, 2001

09/787371



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.

09/787371

FIRST NAME, LAST NAME

RECEIVED

MORTEN

ATTY. DOCKET NO.

P277176

INTERNATIONAL APPLICATION NO.

PCT/GB99/03057

PILLSBURY WINTHROP LLP
1100 NEW YORK AVENUE, N.W.
9TH FLOOR
WASHINGTON, DC 20005

APR 19 2001

CLF

MT# 277176

I.A. FILING DATE

15 SEP 99

PRIORITY DATE

19 SEP 98

ATTY(S)

DTB

DUE:

MAY 17, 2001

UNT BY (1)

LMS

DATE MAILED:

17 APR 2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- | | |
|--|--|
| <input checked="" type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Indication of Small Entity Status. |
| <input checked="" type="checkbox"/> Copy of the international application. | <input checked="" type="checkbox"/> Translation of the international application into English. |
| <input type="checkbox"/> Oath or Declaration of inventor(s). | <input type="checkbox"/> Translation of Article 19 amendments into English. |
| <input type="checkbox"/> Copy of Article 19 amendments. | <input checked="" type="checkbox"/> Other: Assignment, Sequence Listing |
| <input checked="" type="checkbox"/> Priority Document. | IDS |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. | |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. | |

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee. ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☐ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☒ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.

7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☐ PCT/DO/EO/917
☐ PTO-875

☐ Notice of Defective Translation
☒ PCT/DO/EO/920

Francine Young

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3662



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.

09/787371

FIRST NAMED APPLICANT

MORTEN

ATTY. DOCKET NO.

J

P277176

INTERNATIONAL APPLICATION NO.

PCT/GB99/03057

PILLSBURY WINTHROP LLP
1100 NEW YORK AVENUE, N.W.
9TH FLOOR
WASHINGTON, DC 20005

I.A. FILING DATE

15 SEP 99

PRIORITY DATE

19 SEP 98

DATE MAILED: 17 APR 2001

**NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- ☒ The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- ☐ This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- ☒ A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(c).
- ☐ A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☐ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ Other: _____

APPLICANT MUST PROVIDE:

- ☒ An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- ☐ An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☒ A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

**FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE
CALL:**

(703) 308-4216, for Rules interpretation,
(703) 308-4212, for CRF submission help,
(703) 287-0200, for PatentIn software help.

Francine Young

Telephone: 703-305-3662